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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/067,918	02/08/2002	Shigekazu Shuku	SAE-027	8669

20374 7590 01/29/2004

KUBOVCIK & KUBOVCIK
SUITE 710
900 17TH STREET NW
WASHINGTON, DC 20006

EXAMINER

HESS, BRUCE H

ART UNIT PAPER NUMBER

1774

DATE MAILED: 01/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/067,918

Applicant(s)

Shuku et al.

Examiner

Bruce Hess

Group Art Unit

1774

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on 10-5-03 (Election)
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-16 is/are pending in the application.
- Of the above claim(s) 12-16 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-11 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____.
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

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1. Upon reconsideration, the election of species has been withdrawn.
2. Claims 1-11 are rejected under 35USC 112 (first paragraph) for the reasons set forth below:

A. Claims 1-11 are based upon a non-enabling disclosure in the recital of various foreign (i.e. JIS) test standards. This rejection can be overcome by either 1) submitting a translation of the standards or 2) incorporating the standards into the specification; and

B. Claims 1-11 are broader than the enabling disclosure as a result of applicants' failure to recite the limitation found in claims 3 and 5. Absent these limitations, one of ordinary skill in the art would be able to attain the claimed "distinctness of image, , , of at least 75%" only through undue experimentation.

3. Claims 1-11 are rejected under 35 USC 112 (second paragraph) as being indefinite in the recital of "an outmost layer" (emphasis added). Since the protective layer is the outermost layer, it is suggested that applicants recite "the outermost layer".

4. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicants' statement of the prior art in view of any of the patents to Saito et al. (JP 08-011430), Shuji et al. (JP 08-090907) or Shuji et al. (JP 09-024667).

Applicants' acknowledge in their specification that heat-sensitive recording material having a support, a heat – sensitive recording layer, a protective layer and, optionally, intermediate and adhesive layers are known in the art. The secondary references teach the advantage of forming protective layers on a smooth- surfaced substrate and then removing the smooth – surfaced substrate. Use of the smooth –

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surface technique of the secondary references for its concomitant function (i.e. good quality images) in the manufacture of the recording material of the primary reference would have been obvious to one of ordinary skill in this art in the absence of unexpected result.

5. Applicants' attention is drawn to the fact that their specification examples demonstrate that the limitation of claims 3 and 5 together constitute a result – effective parameter. A claim reciting both of these limitations would be allowable. Process claims reciting both of these limitations could be rejoined and allowed also.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruce Hess whose telephone number is (571) 272-1525. The examiner can normally be reached on Monday to Friday 9 Am to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



B.Hass/af
January 16, 2004

BRUCE H. HESS
PRIMARY EXAMINER